

## REMARKS

Claims 35-74 remain pending in this application. Independent claims 35, 45, 54, and 68 have been amended to more clearly define the presently claimed invention. Applicants respectfully request reconsideration of all the pending claims in view of the remarks presented below.

### **Claims Rejected under 35 U.S.C. § 102(e)**

Claims 35-40, 42-50, 52-74 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,171,327 to Daniel et al. (“the Daniel patent”). Applicants submit that the Daniel patent fails to disclose a number of the elements, along with the structural relationships between these elements, as recited in the pending claims. First, the presently claimed inventions defined by claims 35, 45, 54 and 68 recite a system for recovering an embolic protection device which includes an inner catheter with a distal portion having a length of flexible tubing of at least three centimeters which extends outside of the recovery sheath in a delivery position. This distally exposed length of flexible tubing enters the target area of the body vessel before the recovery sheath during initial delivery of the system. Once this exposed distal end of the flexible tubing is in place, the physician can then move the recovery sheath distally to track over the flexible tubing. The flexible tubing provides a track over which the larger diameter recovery sheath moves to recover the expanded embolic protection device. This recovery system helps to reduce the possibility that the larger diameter recovery sheath will straighten the body vessel while the recovery sheath is being deployed in a curved portion of the body vessel while recovering the embolic protection device. With the length of the exposed tubing of the inner catheter being at least three centimeters, the recovery sheath should be able to properly track over this tubing once placed in the body vessel.

Applicants submit that such a structure is simply not shown in the Daniel patent. Applicants note that the inner catheter, which the Examiner has identified as component (172) in FIG. 20 or component (372) in FIG. 23 of the Daniel patent, includes only a small tapered portion (180) which barely extends beyond the recovery sheath (150)

during usage. This distal tapered portion (180) is the end portion of a large portion (176) which is housed within the recovery sheath and is designed to provide a relatively soft and atraumatic tip to the composite catheter. This portion (176) remains within the lumen or housing of the recovery sheath during delivery with only a small portion of the tapered portion (180) extending beyond the end of the recovery sheath during delivery.

The Examiner's position regarding the identity of the location of the distal portion of the inner catheter can be found at page 6, lines 1-7 of the Office Action which reads as follows:

The distal portion (172, 180) is part of the inner catheter, which is a flexible tube. Examiner does not consider only the tip of the inner catheter to be the distal portion of the inner catheter. The "distal portion" can be any length of the inner catheter distal to the most proximal point. Therefore, the Daniels device includes a length of the inner catheter that is at least as long as the filter. The "recovery sheath does "move over" the entire inner catheter, so this argument is not found to be persuasive.

However, in the pending claims, the **distal portion** of the inner catheter is defined as that portion of the inner catheter which extends out of the distal end of the recovery sheath when the components are placed in the delivery position. The length of this distally exposed length of tubing is at least three centimeters. While the Examiner may be correct in stating that the distal portion (172, 180) is a part of the inner catheter, the only portion of the inner catheter of the Daniel device which extends distally out of the recovery sheath is this small tapered portion (180) which barely extends beyond the housing (152) when placed in the delivery position. This tapered portion (180), in fact, is designed to **fill** in the lumen of the housing (152) during delivery to prevent the distal end of the housing (150) from "snowplowing" or scraping the sides of the body vessel as the retrieval catheter is being advanced within the patient. For this reason, the distal tip portion (180) is specifically constructed to remain adjacent to the housing (150) during delivery. There is no disclosure or teaching in the Daniel patent that this distal tapered portion (180) should be at least three centimeters in length or that it should be long enough to serve as a track for the housing (150).

The Examiner's position as to what constitutes the distal portion of the inner member is further incorrect. In the claims, the distal portion cannot be "any length of the inner catheter distal to the most proximal point" as stated by the Examiner. Rather, the present claims recite that the distal portion of the inner catheter is the at least three centimeters length of tubing that extends distally out of the recovery sheath when the inner catheter and recovery sheath are placed in the delivery position. Again, the only portion of the inner catheter of the Daniels device which extends beyond the recovery sheath is this small tapered tip 180. Therefore, the Examiner's position that the "distal portion" can be any length of the inner catheter distal to the most proximal point simply misconstrues the particular structure recited in the present claims.

In the Advisory Action dated February 29, 2006, the Examiner states that the inner tube of the Daniels device "could be moved to extend farther beyond the sheath." Applicants respectfully point out to the Examiner that the inner member of the Daniels device is in its furthest distally extending position as is shown in FIGS. 20-23. The control handle associated with the inner member and housing prevents the inner member from extending any further distally from the housing. The control handles shown in the Daniels patent allow the housing to be moved distally with respect to the tip (180). Accordingly, it would be impossible to let out a longer length of the inner member from the distal end of the recovery sheath as suggested by the Examiner. This makes sense since the tapered tip (180) is designed to remain immediately adjacent to the housing to prevent snow plowing during delivery. Additionally, there is absolutely no teaching or even a remote suggestion that the tapered tip (180) could be constructed with a longer length.

#### **Claims Rejected under 35 U.S.C. § 103(a)**

Claims 41 and 51 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Daniel patent in view of U.S. Patent No. 5,201,757 to Heyn et al. ("the Heyn patent"). Claim 38 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the Daniel patent itself. In view of the remarks addressed above with respect to the presently

claimed invention defined by claims 35 and 45, it is believed that the particular combination of the Daniel patent with the Heyn patent, or the Daniel patent itself, fails to achieve the claimed structure. Applicants respectfully request the Examiner to withdraw the obviousness rejections against claims 38, 41 and 51.

In view of the foregoing, it is respectively urged that all of the present claims of the application are patentable and in a condition for allowance. The undersigned attorney can be reached at (310) 824-5555 to facilitate prosecution of this application, if necessary.

In light of the above remarks, Applicants respectfully request that a timely Notice of Allowance be issued in this case.

The commissioner is authorized to charge any deficiencies in fees or credit any overpayments to our Deposit Account No. 06-2425.

Respectfully submitted,

FULWIDER PATTON LLP

By: /Thomas H. Majcher/  
Thomas H. Majcher  
Registration No. 31,119

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